

### **REMARKS**

This is a full and timely response to the Office Action mailed November 18, 2004.

No claims have been amended in this response. Thus, claims 1-20 remain pending in this application.

In view of this response, Applicant believes that all pending claims are in condition for allowance. Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

#### **Rejection under 35 U.S.C. §102**

Claims 1-20 are rejected under 35 U.S.C. §102(a) as allegedly being anticipated by Chino et al. (U.S. Patent Publication 2002/0022700). Applicant respectfully traverses this rejection.

To constitute anticipation of the claimed invention under U.S. practice, the prior art reference ***must literally or inherently teach*** each and every limitation of the claims. Here, in this case, Chino et al. does not teach the claimed limitation “*a compound containing a metal element belonging to Group 1 of the periodic table*”.

Chino et al. discloses a thermoplastic elastomer composition which contains a thermoplastic elastomer having a carbonyl-containing group and a nitrogen-containing n-membered ring-containing group ( $n \geq 3$ ) in side chains. The nitrogen-containing n-membered ring-containing group is bonded to a main chain at 3-position to n-position directly or through an organic group, and ***a compound of at least one of metal elements selected from the group consisting of Group 2A, Group 3A, Group 4A, Group 5A, Group 6A, Group 7A, Group 8, Group 1B, Group 2B, Group 3B, Group 4B and Group 5B in the Periodic Table***. According to paragraph [141] of Chino et al., Groups 2A, 3A, 4A, 5A, 6A, 7A, 8, 1B, 2B, 3B, 4B and 5B are groups under the IUPAC 1970 nomenclature. They have since been renumbered under a new system (i.e. IUPAC advice, 1990) to correspond to Groups 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14 and 15, respectively. Hence, since Group 1 (i.e. Group 1A - IUPAC 1970 nomenclature) is not listed, Chino et al., fails to teach ***a compound containing a metal element belonging to Group 1 of the periodic table***. As further evidence, Applicant has provided a history of the Group numbers for the Periodic Table from online encyclopedia, Wikipedia.

Thus, based on the submitted evidence and the disclosure of Chino et al., withdrawal of this rejection is respectfully requested.

Applicant acknowledges that in Chino et al., monovalent metal elements, Na, K, and Li are disclosed in the specification. However, the monovalent metal elements were added to the disclosure by mistake. As evidence of such a mistake, in paragraph [0141] and claims 21-23, monovalent metal elements Na, K, and Li are disclosed even though Group 1 (i.e. Group 1A - IUPAC 1970 nomenclature) is not disclosed as an acceptable Group. The disclosure and in particular, claims 21-23 are inherently vague since monovalent metal elements, Na, K, and Li are not part of any of the Group listed in claim 18.

In further support of such a conclusion, Applicant will submit a Rule 1.132 Declaration from the inventors of Chino et al. confirming such an error and that the disclosure of Chino et al. does not adequately teach (i.e. "enable") one skilled in the art how to make and use the disclosed thermoplastic elastomer compositions comprising a compound containing Na, K, or Li.

Under U.S. case law, the disclosure in a cited reference must be enabling with regard to its anticipatory subject matter in order for the reference to be applicable as prior art. Merely naming or describing the subject matter is insufficient, if it cannot be produced or practiced without undue experimentation. *Elan Pharm., Inc. v. Mayo Foundation for Medical and Education Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003).

Thus, the disclosure of the metal elements, Na, K, and Li, in Chino et al. are not applicable as prior art in view of the above comments, Rule 1.131 Declaration and U.S. case law. Hence, withdrawal of this rejection is respectfully requested.

### CONCLUSION

For the foregoing reasons, all the claims now pending in the present application are believed to be clearly patentable over the outstanding rejections. Accordingly, favorable reconsideration of the claims in light of the above remarks is courteously solicited. If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the below-listed number.

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Respectfully submitted,

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Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 180013 for any such fees; and applicant(s) hereby petition for any needed extension of time.

Attachment